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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/557,822	04/25/2000	Timothy A. Barton	2799CIP	9903

7590 09/07/2004

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EXAMINER

NORMAN, MARC E

ART UNIT	PAPER NUMBER
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3744

DATE MAILED: 09/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/557,822	<b>Applicant(s)</b> BARTON, TIMOTHY A.	
	<b>Examiner</b> Marc E. Norman	<b>Art Unit</b> 3744	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 18 June 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 22-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 22-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 29 and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by the FedEx website (as scanned by archives.com on 12 January 1998).

As per claim 29, the FedEx system teaches the web site collecting class, weight, and destination information (Rate Finder at pages 4-5 of website), presenting cost information (by clicking “show rates” button at top of page 5), scheduling a shipment (via FedEx Ship software (pages 9-11), and schedule a time and date of the shipment (see for example bottom of page 4).

As per claim 30, the FedEx system allows the user to track a shipment (page 6).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 22-28 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over the FedEx system (as taught by the Business Wire article and the FedEx web site) in view of Viking Freight (as taught by the previously applied web documents and the newly cited pages from the same web site).

As per claim 22, the Business Wire article announces the FedEx interNetShip internet-based system for ordering freight services allowing a user to enter a freight delivery service request and schedule a shipment. The article does not discuss the specific information entered during these steps or the reviewing of shipment status. The FedEx website (as scanned by Archive.org on January 12, 1998) teaches a service rate request form (pages 4&5) allowing a user to enter source and destination zip codes, class (packaging), weight, and accessorial services (special handling options at bottom of page 4). The service request form also allows for entry of ship (i.e., ready) date (bottom of page 4). The FedEx Ship software (page 10) allows the user to enter shipping/receiving addresses, invoice information (page 10: features of version 2.0). The FedEx tracking page (page 6) allows review of shipment status. The various documents regarding the FedEx software do not specifically teach the entering of member discount information. The Viking Freight rate request software teaches entering member discount

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information (i.e., entering "Vik-Code" for customized rate quotations). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine this feature with the disclosed features of the Fed Ex on-line shipping system for the purpose of incorporating member discounts into the shipping price, since both sites are directed to on-line shipping services and further since member discounts are well-established business practices both in and beyond the realm of freight shipping.

As per claim 23, the FedEx literature does not specifically mention whether the software prints a bill of lading. However, it does describe printing out bar-coded shipping documents (page 3, lines 1-3 of website). Viking Freight teaches providing a bill of lading (page 3 of the newly cited pages of the web site). Such bills of lading are common shipping documents that would have been obvious to one of ordinary skill at the time of the invention to include as one of the printable shipping documents of the FedEx system for the simple purpose of user convenience.

As per claim 24, the FedEx literature teaches creating an invoice (page 10: features of version 2.0).

As per claim 25, the Applicant is referred to the rejections of this subject matter set forth in the previous Office Actions. In particular, Viking Freight (and the FedEx system) discloses an internet-based system for ordering freight services at a user computer comprising sequentially displaying a plurality of accessorial services (see accessorial services listed sequentially at bottom half of upper right frame) and requiring the user to address/accept/decline each of the accessorial services (by either checking or not checking the checkbox associated with each service), wherein the services comprise at least inside delivery and residential delivery. Since

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Viking Freight (and the FedEx system) is an internet-based system, it inherently functions using a server computer and distributed network, and further includes a database containing accessorial service information (used to determine shipping rate based on chosen services). The Examiner notes that the phrase "requiring the user" is vague for the purposes of patentability. Under its broadest interpretation, displaying the services on the screen where the user must either check or not check each box can be considered requiring the user to accept or decline each of the services. For purposes of patentability, the claim must recite more specifically how the requiring step of applicant's invention is performed.

As per claim 26 and 31, see discussion above of claim 25.

As per claim 27, see discussion above of claim 23.

As per claim 28, see discussion above of claim 24.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc E. Norman whose telephone number is 703-305-2711. The examiner can normally be reached on Mon.-Fri., 8:00-5:30, with first Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Denise Esquivel can be reached on 703-308-2597. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MN

A handwritten signature in black ink, appearing to read 'Marc Norman', with a stylized, flowing script.

MARC NORMAN  
PRIMARY EXAMINER